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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,271	10/26/2000	Yoichiro Sako	6715/60007	2353
530 7590 08/08/2006 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER TRAN, TONGOC	
			ART UNIT 2134	PAPER NUMBER

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,271

Applicant(s)

SAKO ET AL.

Examiner

Tongoc Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 7-9, 11, 13-15, 18-20, 23-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 7-9, 11, 13-15, 18-20 and 23-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to Applicant's amendment filed on May 5, 2006. Claims 2-4, 7-9, 11, 13-15, 18-20 and 23-44 have been amended. Claims 45-65 have been added. Claims 2-4, 7-9, 11, 13-15, 18-20 and 23-65 are pending for examination.

Response to Arguments

2. In light of Applicant's argument presented in the remark. Previous rejection under U.S.C. 112 has been withdrawn.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The cited sections of Shear do not disclose controlling the stopping of the transmission of digital data *while providing the analog output* are not recited in the rejected claim(s) (the cited language does not distinguish the type of data signal being transmitted in the independent claims). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-4, 7, 9, 11, 13-15, 18-20 and 24-40 and 45-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Shear (US Patent Application Publication US200110042043).

In respect to claims 2-4, 7, 9 and 11, Shear discloses the data transmitting apparatus, comprising:

an interface connectable to various external apparatus comprising: reproducing means for reproducing data (see page 21, [0296], one or more personal computers);

external-apparatus identifying means for determining a type of an external apparatus identifying means for determining *a type of an external apparatus* (claims 2 and 9), or *version of the external apparatus* (claim 3), or *a copyright-related apparatus* (claim 4), *according with an amount of the signal* (claim 7) or connected to said interface and for outputting data representing the type of the external apparatus (see page 20, [0282, “controls may prevent platform from releasing content except to certain types of output devices that cannot used to make copy the content”; “For example, ...supplies the platform a digital ID that designates the output device as a video cassette recorder...”, [0056, “copy may

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be playable only on intended receiving devices, class(es) of devices...right related to use of such copy..."; "charge for use of portion" {0092}); and

control means for controlling stopping of transmission of a first signal derived from the reproduced data to the external apparatus through the interface in accordance with a result of the determining of the type of the external apparatus by said external apparatus identifying means while said reproducing means reproduces the reproduced data and outputs a second signal derived from the reproduced data, wherein said external apparatus identifying means determines whether the external apparatus is a storage apparatus that has a storage memory means for storing signals inputted through the interface, and said control means stops the transmission of the first signal to identifying means determines that the external apparatus is the storage apparatus having the storage memory means (see page 11, [0168], "For example, dedicated player may prevent any copying of content stored by disk or it may allow the content to be copied only once and never again ", this implies prohibiting the output or enable the copying while control the data signal and stopping the outputting signal when certain condition is met, first and second signal recited in the claim language does not distinguish between digital or analog signal, therefore, the limitation is met).

Fee charging means for charging a fee in accordance with the transmission of the first signal through the interface, and said control means controls a fee charging process performed by the fee charging means, in accordance with the result of determining made by the external means, in

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accordance with the result of determining made by the external apparatus identifying means of the type of external apparatus (claim 11). (see page 8, [0092], "where they may charge for the use of a portion").

In respect to claims 13-15, 18-20 and 24-40, the claimed limitations are apparatus and method claims that are similar to claims 2-4, 7, 9 and 11. Therefore, claims 13-15, 18-20 and 24-40 are rejected based on the similar rationale.

In respect to claims 45-61, Shear further discloses wherein the first signal is a digital audio signal, and the second signal is a signal *selected from the group* consisting of an analog audio signal, a digital video signal, and an analog video signal (see Shear, page 5, [0056], digital consumer appliance; [0061-0068])

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41- 44 and 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al. (U.S. Patent Application Publication, US 200110042043) in view of Ottesen et al. (U.S. Patent No. 5,654,747).

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In respect to claims 41- 44, Shear discloses a data transmitting method for use in a data transmitting apparatus for transmitting, through an interface, output data reproduced from a recording medium, the method comprising: a fee-charging control step of performing a fee-charging process in accordance with the transmission of output data through the interface and controlling the transmission of output data (see Shear [0092]). Shear does not explicitly disclose wherein the fee-charging control step is to perform the fee-charging process by "updating", in accordance with the fee to be charged, data recorded on the recording medium and corresponding to a sum of fees that can be charged for the recording medium, and to stop the transmission of output data through the interface when the data corresponding to the sum of fees reaches or exceeds a predetermined value during a time when the output data is being reproduced and outputted. However, Ottensen discloses communicating a billing signal to the information network in response to each presentation of a downloaded source program (updating) (see Ottensen, col. 7, line 55-col. 8, line 14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Ottensen by updating the billing information as information is downloaded from source with Shear's teaching of billing for the fee charging control system in order to allow for automatic billing for each program presentation to the customer's account (see Ottensen, col. 8, lines 5-9). Furthermore, Shear does not explicitly disclose stop the transmission of output data when the data corresponding to the sum of fees reaches or exceeds a predetermined value. However, Official Notice is taken that pay for view with

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predetermined selection of program by subscriber is old and well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate stopping output when data corresponding to the sum of fees reaches as in preselect pay for view program with Shear's fee charging control system in order to output program according to subscriber's predetermined on selected program they are interested to view.

In respect to claims 62-65, Shear further discloses wherein the first signal is a digital audio signal, and the second signal is a signal *selected from the group* consisting of an analog audio signal, *a digital video signal*, and an analog video signal (see Shear, page 5, [0056], digital consumer appliance and [0061-0068])

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-3962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT

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